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Thomson Licensing LLC  
P.O. Box 5312  
Two Independence Way  
PRINCETON, NJ 08543-5312

EXAMINER
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REAGAN, JAMES A

ART UNIT	PAPER NUMBER
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3621

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/636,393	<b>Applicant(s)</b> ALLIBHOY ET AL.	
	<b>Examiner</b> JAMES A. REAGAN	<b>Art Unit</b> 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12, 14, 15 and 18-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14, 15 and 18-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 August 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/21/08 (X4)</u> : | 6) <input type="checkbox"/> Other: _____  |

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## **DETAILED ACTION**

### **Status of Claims**

1. This action is in reply to the RCE filed on 8/27/07.
2. Claims 1,2, 4, 8, 28, and 42 have been amended.
3. Claims 13, 16, an 17 have been canceled.
4. Claims 1-12, 14, 15, and 18-50 are currently pending and have been examined.

### **Information Disclosure Statement**

5. The Information Disclosure Statements filed 4/21/08; 4/21/08; 4/21/08; and 4/21/08 have been considered. Initialed copies of the Form 1449 are enclosed herewith.

## **RESPONSE TO ARGUMENTS**

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6. Applicant's arguments received on 8/27/07 have been fully considered but they are not persuasive. Referring to the previous Office action, Examiner has cited relevant portions of the references as a means to illustrate the systems as taught by the prior art. As a means of providing further clarification as to what is taught by the references used in the first Office action, Examiner has expanded the teachings for comprehensibility while maintaining the same grounds of rejection of the claims, except as noted above in the section labeled "Status of Claims." This information is intended to assist in illuminating the teachings of the references while providing evidence that establishes further support for the rejections of the claims.
7. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

#### **Claim Rejections - 35 USC § 112.**

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 14 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims depend from cancelled claim 13. Correction is required.

#### **Claim Rejections - 35 USC § 103**

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:
1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
13. Claims 1-12, 14, 15, and 18-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ben-Shaul et al (U.S. PG Pub No. 2002/0010798), in view of Stefik et al. (US 6,895,392 B2).

As per claim 1, Ben-Shaul et al teach a method of controlling a financial transaction between a receiver and a content provider occurring over a network operated by a network operator, wherein the content provider offers enhanced content programming relating to the financial transaction, the method comprising intercepting a user request for the enhanced content programming, the user request originating in the receiver, wherein the intercepting is performed by a third party (software or hardware module, edge server, 72) (see figs 7 and 8, paragraphs 0180, 0214, 0220.), permitting (permitting) the enhanced content programming the (content) be provided (downloading) to the receiver in response to the user request only if the content provider is an authorized content provider, wherein the permitting is performed by the third party (see paragraph 0426), and storing information relating to the enhanced content programming provided to the receiver in response to the user request, wherein the storing is performed by the third party (see paragraphs 0022, 0072, 0107). In addition, Ben-Shaul et al teach a method of determining if the content provider is

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authorized to provide enhanced content programming to the user receiver (see figs 7 and 8, paragraphs 0220, 0072, 0107, 0180, 0214). Furthermore, Ben-Shaul discloses in paragraphs 0220, 0072 redirect, 0180 interception of data packets, 0214 mirror sites, interceptions, and redirect back to origin website if a server has failed. Ben Shaul does not specifically disclose preventing content transmission is a content provider is unauthorized. Stefik, however, discloses trustworthy repositories (see at least Figures 1 and 2, item #205 as well as associated text), hotlist repositories that are untrusted (see at least Figures 16 and 17 as well as associated text) and redirecting of content requests away from hotlisted repositories towards alternative repositories, where the repositories are not associated with a third party. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the content provider system of Ben-Shaul with the redirection to another repository feature of Stefik because this would, "...prevent the unauthorized and unaccounted distribution or usage of electronically published materials" (Stefik: column 1, lines 21-25).

As per claim 2, Ben-Shaul et al teach a method further comprising determining if the content provider is authorized by the network operator to offer enhanced content programming over the network (see paragraph 0426). In addition, Ben-Shaul et al teach a method of determining if the content provider is authorized to provide enhanced content programming to the user receiver (see figs 7 and 8, paragraphs 0220, 0072, 0107, 0180, 0214). Furthermore, Ben-Shaul discloses in paragraphs 0220, 0072 redirect, 0180 interception of data packets, 0214 mirror sites, interceptions, and redirect back to origin website if a server has failed. Ben Shaul does not specifically disclose preventing content transmission is a content provider is unauthorized. Stefik, however, discloses trustworthy repositories (see at least Figures 1 and 2, item #205 as well as associated text), hotlist repositories that are untrusted (see at least Figures 16 and 17 as well as associated text) and redirecting of content requests away from hotlisted repositories towards alternative repositories, where the repositories are not associated with a third party. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the content provider system of Ben-Shaul with the redirection to another repository feature of Stefik because this would, "...prevent the unauthorized and unaccounted distribution or usage of electronically published materials" (Stefik: column 1, lines 21-25).

As per claim 3, Ben-Shaul et al teach a method further comprising of monitoring for triggers within the enhanced content programming (see paragraphs 0190, 0211, 03273).

As per claim 4, Ben-Shaul et al teach a method further comprising terminating the user request after the intercepting if the content provider is unauthorized (see paragraph 0414).

As per claim 5, Ben-Shaul et al teach a method further comprising intercepting a supplemental user request intercepting is performed by the third party; storing the supplemental user request, wherein the, the supplemental user request originating in the receiver, wherein the storing is performed by the third party; and requesting supporting information from the content provider for the supplemental user request, wherein the requesting is performed by the third party (see paragraphs 0022, 0072, 0107).

As per claim 6, Ben-Shaul et al teach a method further comprising of providing the supporting information to the receiver upon request (see paragraph 0152).

As per claim 7, Ben-Shaul et al teach a method further comprising intercepting a request to finalize the supplemental user request, the request to finalize the supplemental user request originating in the receiver, wherein the intercepting is performed by the third party, finalizing the supplemental user request, wherein the finalizing is performed by the third party; and supplying the content provider with finalized supplemental user request information (see paragraphs ppJ2, 0072, 0107).

As per claim 8, Ben-Shaul et al teach a method of motoring a network transaction between a user receiver and a content provider, the method comprising intercepting a user request directed at the content provider by the user receiver; appending additional parameters to the user request; directing the appended user request to the content provider, intercepting a user request response directed at the user receiver by the content provider, wherein the user request response comprises at least a portion of the network transaction, extracting transaction information from the intercepted user request response; and forwarding the user request response by the third party to the user receiver ( see figs 7 and 8, paragraphs 0220, 0072, 0107, 0180 0214). Ben Shaul does not specifically disclose termination of a transaction. Stefik, however, discloses trustworthy repositories (see at least Figures 1 and 2, item #205 as well as associated text), hotlist repositories that are untrusted (see at least Figures 16 and 17 as well as associated text) and redirecting of content requests away from hotlisted repositories towards alternative repositories, where the repositories are not associated with a third party, and termination of transactions. It would have been

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obvious to one of ordinary skill in the art at the time of the invention to combine the content provider system of Ben-Shaul with the redirection to another repository feature of Stefik because this would, "...prevent the unauthorized and unaccounted distribution or usage of electronically published materials" (Stefik: column 1, lines 21-25).

As per claim 9, Ben-Shaul et al teach a method further comprising of initially receiving enhanced content programming from the content provider within the user receiver, and wherein the user request is formed by of interacting with the content provider through the user receiver (see paragraphs 0180, 0214).

As per claim 10, Ben-Shaul et al teach a method further comprising of recognizing a trigger within the enhanced content programming, the recognizing performed prior to of intercepting the user request (see figs 7 and 8, paragraphs 0220, 0072, 0107, 0180, 0214).

As per claim 11, Ben-Shaul et al teach a method wherein of intercepting the user request further comprises appending an address to a third party controller to the intercepted user request and directing the intercepted user request to the third party controller, wherein the third party controller performs of appending additional parameters to the user request (see figs 7 and 8, paragraphs 0220, 0072, 0107, 0180, 0214).

As per claims 12, Ben-Shaul et al teach a method of appending a marker to the user request response by the content provider, wherein the third party uses the marker to intercept the user request response (see figs 7 and paragraphs 0220, 0072, 0107, 0180, 0214).

As per claims 14, and 5, Ben-Shaul et al teach a wherein the determining is performed prior to the first intercepting and after the user request is intercepted by the third party (see figs 7 and 8, paragraphs 0220, 0072, 0107, 0180 0214).

As per claims 18, Ben-Shaul et al teach a method of storing the extracted transaction information (see figs 7 and 8, paragraphs 0220, 0072, 0107, 0180, 0214).



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As per claims 19, Ben-Shaul et al teach a method of initiating a purchase from the content provider by the user receiver; and entering the initiated purchase into a data base controlled by a third party (see paragraphs 0180, 0214).

As per claims 20, Ben-Shaul et al teach a method of displaying information pertaining to the initiated purchase on a display screen coupled to the user receiver (see paragraphs 0190, 0211, 0327).

As per claims 21, Ben-Shaul et al teach a method of displaying at least one advertisement on the display screen simultaneously with the information permitting to the initiated purchase (see paragraph 0426).

As per claims 22, Ben-Shaul et al teach a method wherein at least one advertisement includes linking information to a specific content provider. (see paragraph 0414).

As per claims 23, Ben-Shaul et al teach a method of directing a request for additional information pertaining to the initiated purchase to the content provider, wherein the directing is performed by the third party receiving the additional information from the content provider by the third party; and storing the additional information in the third party controlled database (see figs 7 and 8, paragraphs 0220, 0072, 0107, 0180, 0214).

As per claims 24, Ben-Shaul et al teach a method of directing a request for updated information pertaining to the initiated purchase to the content provider, wherein the directing is performed by the third Party, receiving the updated information from the content provider by the third party; and storing the updated information in the third party controlled data base (see figs 7 and 8, paragraphs 0072, 0107, 0180, 0214).

As per claims 25, Ben-Shaul et al teach a method of requesting finalization of the initiated purchase by the user receiver; finalizing the initiated purchase with the user receiver, wherein the providing final purchase information to the content provider by the third finalizing is performed by the third party; and party (see figs 7 and 8, paragraphs 0220, 0072, 0107, 0180, 0214).

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As per claims 26, Ben-Shaul et al teach a method of requesting finalization of the initiated purchase by the user receiver, wherein the requesting is performed prior to the finalizing (see paragraph 0414).

As per claims 27, Ben-Shaul et al teach a method of obtaining supplemental information from the user by the third party in order to complete the finalizing (see paragraph 0414).

As per claims 28, Ben-Shaul et al teach a method of controlling a network transaction comprising directing enhanced broadcast information via a network to a plurality of receivers, wherein the network is controlled by a network operator, and wherein at least a portion of the enhanced broadcast information is provided by at least one content provider, detecting triggers within the portion of the enhanced broadcast information provided by the at least one content provider, wherein the detecting is performed by a third party; intercepting by the third party a user request directed at the at least one content provider from a receiver of the plurality of receivers coupled to the network, directing the intercepted user request to a third party controller, appending third party parameters to the intercepted user request; directing the appended user request to the at least one content provider; appending third party markers to a response to the appended user request, wherein the appending is performed by the at least one content provider; directing the appended response to the receiver; detecting by the third party controller the third party markers appended to the response, and storing transaction information provided by the at least one content provider in the response, wherein the storing is controlled by the third party controller (see figs 7 and 8, paragraphs 0220, 0072, 0107, 0180, 0214). In addition, Ben-Shaul et al teach a method of determining if the content provider is authorized to provide enhanced content programming to the user receiver (see figs 7 and 8, paragraphs 0220, 0072, 0107, 0180, 0214). Furthermore, Ben-Shaul discloses in paragraphs 0220, 0072 redirect, 0180 interception of data packets, 0214 mirror sites, interceptions, and redirect back to origin website if a server has failed. Ben Shaul does not specifically disclose preventing content transmission is a content provider is unauthorized. Stefik, however, discloses trustworthy repositories (see at least Figures 1 and 2, item #205 as well as associated text), hotlist repositories that are untrusted (see at least Figures 16 and 17 as well as associated text) and redirecting of content requests away from hotlisted repositories towards alternative repositories, where the repositories are not associated with a third party. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the content provider

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system of Ben-Shaul with the redirection to another repository feature of Stefik because this would, "...prevent the unauthorized and unaccounted distribution or usage of electronically published materials" (Stefik: column 1, lines 21-25).

As per claims 29, Ben-Shaul et al teach a method of appending information to the intercepted user request prior to directing the intercepted user request to the third party controller (see paragraph 0426).

As per claims 30-32, Ben-Shaul et al teach a method, wherein the information appended to the intercepted user request is comprised of a third party controller address, receiver capabilities and user profile associated with the receiver (see paragraphs 0190, 0211, 0327.).

As per claims 33-36, Ben-Shaul et al teach a method wherein appended third party parameters comprised of a network specification, a receiver specification, a user profile associated with the receiver and a set of network operator business rules (see figs 7 and 8, paragraphs 0220, 0107, 0180, 0214.).

As per claims 37, Ben-Shaul et al teach a method of initiating a user financial transaction through the receiver with the at least one content provider, storing information pertaining to the user financial transaction in a third party controller data base and displaying at least a portion of the stored information on a display screen coupled to the receiver (see paragraph 0414.).

As per claims 38, 39, Ben-Shaul et al teach a method of displaying at least one advertisement on the display screen simultaneously with the portion of the stored information and includes linking information to a specific content provider (see paragraphs 0190, 0211, 0327).

As per claims 40, Ben-Shaul et al teach a method requesting additional information on the user financial transaction from the at least one content provider, wherein the requesting is performed by the third party controller, receiving the additional information from the at least one content provider and storing the additional information (see paragraphs 0190, 0211, 0327).

As per claims 41, Ben-Shaul et al teach a method of finalizing the user financial transaction through the receiver, wherein of finalizing is executed between the receiver and the third party controller, and providing finalized user financial transaction information to the at least one content provider by the third party controller (see paragraphs 0190, 0211, 0327,).

As per claims 42, Ben-Shaul et al teach a network-based system for providing enhanced content programming to a user, the system comprising a network a content provider coupled to the network, wherein the content provider supplies the enhanced content programming a receiver coupled to the network the receiver capable of receiving the enhanced content programming, a display coupled to the receiver for displaying the enhanced content programming to the user; third party means for intercepting a request initiated by the receiver and directed at the content provider, third party means for appending operational parameters to the request, third party means for directing the appended request to the content provider; third party means for intercepting a response to the request initiated by the content provider; and a database coupled to the network and the third party means for storing intercepted response information (see fig 7 and 8, paragraphs 0220, 0072, 0107, 0180, 0214.). Ben Shaul does not specifically disclose termination of a transaction. Stefik, however, discloses trustworthy repositories (see at least Figures 1 and 2, item #205 as well as associated text), hotlist repositories that are untrusted (see at least Figures 16 and 17 as well as associated text) and redirecting of content requests away from hotlisted repositories towards alternative repositories, where the repositories are not associated with a third party, and termination of transactions. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the content provider system of Ben-Shaul with the redirection to another repository feature of Stefik because this would, "...prevent the unauthorized and unaccounted distribution or usage of electronically published materials" (Stefik: column 1, lines 21-25).

As per claims 43, Ben-Shaul et al teach a network-based system wherein third party means for intercepting the request further comprising third party means for appending an address for a third party controller to the request, wherein the request is directed at the third party controller (see paragraphs 0190, 0211, 0327).

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As per claims 44, Ben-Shaul et al teach a network-based system the third party means for intercepting the request further comprising third party means for monitoring transactions between the receiver and the content provider (see paragraph 0426).

As per claims 45, Ben-Shaul et al teach a network-based system wherein the third party monitoring means detects triggers contained within the enhanced content programming (see paragraph 0414).

As per claims 46, Ben-Shaul et al teach a network-based system wherein the third party controller displays information on transactions between the user and the content provider on the receiver coupled display (see paragraph 0426).

As per claims 47, Ben-Shaul et al teach a network-based system wherein the third party controller displays advertisements simultaneously with the transaction information (see paragraphs 0180, 0214).

As per claims 48, Ben-Shaul et al teach a network-based system wherein the third party controller obtains supplemental information from the content provider pertaining to transactions initiated between the user and the content provider (see paragraphs 0180, 0214).

As per claims 49, Ben-Shaul et al teach a network-based system wherein the receiver is selected from the group consisting of set-top boxes, telephones, PDAS, and computers (see figs 7 and 8, paragraphs 0220, 0072, 0180, 0214.).

As per claims 50, Ben-Shaul et al teach a network-based system wherein the network is selected from the group consisting of cable, fiber optics, telephone lines, terrestrial broadcast systems, and satellite broadcast systems (see paragraph 0414).

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Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **James A. Reagan** whose telephone number is **571.272.6710**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **JAMES A. REAGAN** can be reached at **571.272.6710**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> . Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

Any response to this action should be mailed to:

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/James A. Reagan/

Primary Examiner, Art Unit 3621